

REMARKS

Claims 1-69 are pending in the application and claims 4-17, 19-24, 26, 27, 29-34, 40-42, and 59-69 were withdrawn from consideration as directed to nonelected invention/species. No claim amendments are made in this reply.

I. Rejections Under 35 U.S.C. § 103

A. Sweger in view of Matsumoto and Uchiyama

The Office has rejected claims 1-3, 18, 25, 28, 38, 39, and 43-58 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,482,704 to Sweger et al. ('Sweger') in view of U.S. Patent No. 6,010,689 to Matsumoto et al. ('Matsumoto') and U.S. Patent No. 5,876,705 to Uchiyama et al. ('Uchiyama'). Office Action at page 2. In this rejection, the Office alleges that Sweger teaches hair compositions containing amino-multicarboxylate modified starch, and refers to Example 1, which teaches a starch modified with z-achloroethylaminopropionic acid (CEPA), as support for this position. *Id.* According to the Office, although Sweger does not teach the remaining ingredients as claimed, it would have been obvious to a person of ordinary skill in the art "to use hair conditioning agents, and surfactants because those are well known essential ingredients normally used for hair compositions." *Id.* at page 3. Applicants respectfully disagree and traverse the rejection for the following reasons.

In order to establish a prima facie case of obviousness, three requirements must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143 (8th ed. Rev. 1, 2003).

The Office's assertions of obviousness are grounded neither in the law, nor in the teachings of the references relied upon. For example, the Office's position that, "because [conditioning agents and surfactants] are well known essential ingredients normally used for hair compositions," somehow supports a prima facie case of obviousness is inaccurate. Office Action at page 3. This statement attempts to rationalize the motivation to combine the references based on what is "normally used" for hair compositions.

Mere identification of claim elements in separate prior art references does not, in itself, preclude patentability. Rather, as described in the M.P.E.P., "[a] statement that modifications of the prior art to meet the claims invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the references." M.P.E.P. § 2143.01. As such, the Office's attempt to rationalize a motivation for the combination on what is "normally used" without providing objective evidence in the references themselves is misplaced and improper. Thus, the rejection should be withdrawn.

Further, the Office's rationale that the claimed ingredients "are well known essential ingredients normally used for hair compositions" is not sufficient to provide the requisite motivation to substitute Sweger's ingredients for those ingredients used in Matsumoto and Uchiyama. Indeed, the nine examples in Sweger evidence the fact that the Office's rationale is based on "obvious to try" standard, which does not support an obviousness-type rejection.

For example, Sweger's examples are directed to the following: a cosmetic lotion (Example II), a moisturizing hand and body lotion (Example III), a sunscreen (Examples IV and V), a shave cream (Example VI), a shave balm (Example VII), a cosmetic lotion for skin treatment (Example VIII), and a liquid talc (Example IX). In contrast, Matsumoto is directed to hair treatment compositions, i.e., conditioning compositions useful in hair compositions. Similarly, Uchiyama is directed to conditioning shampoo compositions. Office Action at page 3. Although the references are all drawn to "cosmetic" compositions, they don't provide the "clear and particular" evidence supporting the combination of references. See *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) (explaining that the motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved but must still be supported by actual evidence that is "clear and particular"). Thus, the Office fails to establish a prima facie case of obviousness and as such, Applicants respectfully request the withdrawal of this rejection.

**B. Janchipraponvej in view of Sweger and Martino and
in further view of Uchiyama**

Further, the Office rejected claims 1-3, 18, 25, 28, 38, 39, and 43-58 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,954,335 to Janchipraponvej ("Janchipraponvej") in view of Sweger and U.S. Patent No. 6,210,689 to Martino et al. ("Martino") and in further view of Uchiyama. Office Action at page 3. Applicants respectfully disagree and traverse the rejection for the following reasons.

In the same manner as provided above, the Office attempts to establish a prima facie case of obviousness using references, in this case Janchipraponvej in view of Sweger and Martino and in further view of Uchiyama, that at most mention different aspects of the claimed invention without any motivation for their combined use. For example, the Office states that Janchipraponvej teaches quaternary ammonium compounds but admits that Janchipraponvej lacks a modified starch and anionic surfactants. Office Action at page 4. The Office asserts that Sweger, Martino and Uchiyama, however, provide for the modified starch, alkyl ether salts as surfactants and the combination of anionic surfactant, conditioning agent and thickener. *Id.* at pages 4-5. Thus, the Office asserts that the presently claimed application would have been obvious by "modify[ing] the compositions of Janchipraponvej by the addition of amphoteric starches as taught by Sweger and anionic surfactants as taught by Martino in order to benefit from the improved results of the amphoteric starches with respect to

viscosity and thickening as taught by Sweger.” *Id.* at page 5. This rationale fails to establish a prima facie case of obviousness.

Again, the Office’s rationale merely identifies the respective ingredients in each reference without pointing to any evidence in the nature of the problem to be solved, the teachings of the prior art or the knowledge of persons ordinary skill in the art to support a motivation to combine the references. M.P.E.P. § 2143.01. Additionally, the teachings in Janchipraponvej, the primary reference, teach away from the combination of references applied by the Office. See M.P.E.P. § 2145 (citing *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983)). The Federal Circuit has repeatedly recognized that proceeding contrary to the accepted wisdom in the art represents “strong evidence of unobviousness.” *In re Hedges*, 783 F.2d 1038, 1041, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1552, 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983).

The Examiner’s responsive remarks to the executed declaration under 37 C.F.R. § 1.132 by Mme. Mahe supports Applicants’ position that the rejections are grounded neither in the law, nor in the reference teachings. For example, the Examiner stated that this declaration was insufficient to overcome this rejection because the generated data “lacks the probative force accorded data generated by independent, disinterested parties.” Office Action at page 5. The Examiner cites *In re Michalek*, 74 U.S.P.Q. 107 (C.C.P.A. 1974) to support this assertion. The Examiner’s reliance, however, on *Michalek* is misplaced.

Michalek stands for the proposition that a patent covering a process is presumed to “provide the product alleged by the patentee and such a presumption is not overcome by a mere showing that it is possible to operate within the disclosure without obtaining the alleged product.” *Id.* at 109. The court explained that because skilled workers can make certain adaptations if they don’t get the desired result, it is not a difficult matter to carry out a process in such a fashion that it will not be successful. *Id.* The court concluded that “the failures of experimenters who have no interest in succeeding should not be accorded great weight.” *Id.* (citation omitted). Thus, the court addressed what weight should be afforded to an affidavit submitted to *contradict* a teaching in a patent.

In the Rule 132 Declaration, Mme. Mahe prepared, according to the method of Example 1 of Janchipraponvej, a composition using the ingredients of Example 25 that resulted in a clear composition, as reported in Janchipraponvej. Mme. Mahe then added 0.1% CEPA starch to this same composition. Because the 0.1% CEPA starch solution is not expressly identified as one of Janchipraponvej’s five essential ingredients, the starch solution must then fall into the category of optional “other common cosmetic compositions” and/or “additives that can be incorporated with the essential ingredients.” Janchipraponvej at Col. 15, ll. 47-54. For the 0.1% CEPA starch to be included into these categories, there is a caveat in Janchipraponvej. *Id.* Janchipraponvej states that the additional ingredients must not adversely affect the basic property of the hair composition, i.e., the clarity of the composition. *Id.*

As depicted and stated in Mme. Mahe's declaration, the added 0.1% CEPA starch solution generated a cloudy composition. Thus, among the optional additives, a CEPA-starch solution cannot be added to the composition because it fails to produce a clear composition. This conclusion is also supported in Janchipraponvej's specification, which teaches that among the optional additives that can be incorporated are thickeners, such as polyacrylic acid derivatives. *Id.* at Col. 16, ll. 9-15. No mention, however, is made to modified starches, such as CEPA-starch, for use as thickeners.

Therefore, Mme. Mahe's declaration does not *contradict* Janchipraponvej but instead confirms the intended clear composition cannot be achieved using the Examiner's rationale. As demonstrated, 0.1% CEPA-starch cannot be one of those additional ingredients because it generates a cloudy solution that is opposite to the Janchipraponvej teachings at Col. 15, l. 47-54. Thus, the Examiner's rationale, which is based on the position that one would look to modify Janchipraponvej's composition with CEPA-modified starch, as disclosed in Sweger, is fundamentally flawed since this combination would destroy the intended use of Janchipraponvej's composition. For this additional reason, this combination does not support a *prima facie* case of obviousness.

In addition, Janchipraponvej teaches that the problem in the art lies with surfactants that "primarily clean" the hair versus "conditioning" the hair. Col. 1, ll. 50-68. In fact, Janchipraponvej provides that anionic surfactants "leave the hair with an undesirable harsh, dull, and dry touch or feel." Col. 2, ll. 3-5. Janchipraponvej states that as a result of the "the overall unsatisfactory condition of the shampooed hair,"

conditioning compositions are applied separately from the hair shampoos containing surfactants. Col. 2, ll. 28-31. This suggests that Janchipraponvej is directed to curing the results of anionic shampoos and not their inclusion into his composition of conditioning compositions, as the Examiner's rationale would dictate.

Even though Janchipraponvej includes "a solubilizing nonionic surfactant" in the conditioning composition, this is not an open invitation to add any surfactant, as suggested by the Office. See Office Action at page 4. In the citation identified by the Office (col. 5, ll. 1-26), the proffered nonionic surfactant is to "*solubilize* the volatile conditioning compound, and to assist in *solublizing* the amidoamine compound, such that the resulting conditioning composition is *clear and homogenous*." Col. 14, ll. 27-31 (emphases added). Whereas, the disclosure of Martino provides, as optional ingredients, a laundry list of "other additives and active and functional ingredients" that *may* be included. Col. 4, line 62-Col. 5, line 10. It is here that the Office cites the inclusion of "surfactants" which are one of sixteen optional ingredients. *Id.* at Col. 5, ll. 10-26.

Given the explicit role the "nonionic" surfactant plays in Janchipraponvej's composition, the inclusion of an optional anionic surfactant from Martino is less than the required "clear and particular" evidence suggesting the combination. Further, the role of the "nonionic" surfactant in Janchipraponvej, i.e., assisting in solubization, suggests that only a "nonionic" surfactant can be utilized and thus, teaches away from a combination of "other" surfactants, including the anionic surfactants taught in Martino. Because

Sweger is relied on for teaching amino-multicarboxylate modified starches and Uchiyama is relied on for teaching a conditioning composition, these references do not cure the deficiencies of the combination of Janchipraponvej and Martino. Therefore, for this independent reason alone, the Office has failed to establish a prima facie case of obviousness and as such, Applicants respectfully request the withdrawal of this rejection.

II. Conclusion


In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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